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OFFICE OF PETITIONS

In re Patent No. 7,514,421 :  
Abrahamsson, et al. : DECISION ON REQUEST  
Issue Date: April 7, 2009 : FOR RECONSIDERATION OF PATENT  
Application No. 10/551,999 : TERM ADJUSTMENT  
Filed: October 4, 2005 :  
Attorney Docket No. 23854-0004US1 :

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(d)," filed on June 9, 2009, requesting that the patent term adjustment determination for the above-identified patent be changed from zero (0) days to nine hundred seventy(970) days.

The request for reconsideration of patent term adjustment is **DISMISSED** with respect to making any changes to the patent term adjustment of zero (0) days.

For the reasons stated herein, the patent term adjustment of zero (0) days has been changed to decrease the period of adjustment for Office delay by 1 day to 148 days. As the patent term adjustment remains 0 days, no further action is required.

On April 7, 2009, the above-identified application matured into U.S. Patent No. 7,514,421 with a patent term adjustment of 0 days.

This request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See 1.705(d).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Patentees request recalculation of the patent term adjustment based on the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees assert that pursuant to Wyeth, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." Patentees maintain that the period of adjustment due to the Three Year Delay by the Office, pursuant to 37 CFR § 1.703(b), of 533 days and the period of adjustment due to examination delay, pursuant to 37 CFR §1.702(a), of 701 days do not overlap, as these periods do not occur on the same day.

Patentees argue that the period of adjustment due to the Three Year Delay by the Office, pursuant to 37 CFR § 1.702(b), is calculated from the application's international filing date to the filing of a RCE.

Patentees are informed that the Three Year Delay period is triggered by the application's commencement date, not the international filing date. The commencement date is 30 months from the priority date claimed in the international application, or earlier<sup>1</sup>. The priority date claimed in the international application is April 5, 2003. Thirty months from that date is October 5, 2005. The period is terminated by the filing of a Request for Continued Examination (RCE). The filing of a RCE cuts-off the applicants' ability to accumulate any additional patent term adjustment against the three-year pendency provision, but does not otherwise affect patent term adjustment. 37 CFR §1.703(b)(1) Accordingly, the period of adjustment under § 1.702(b) is 0 days because a RCE was filed on September 15, 2008 and the Three Year Delay period would have started on October 6, 2008, which is after the RCE was filed.

A discussion of patentees' definition of overlap is not necessary, because there is no period of adjustment under § 1.702(b) in this case. Therefore, the issue of overlap is moot.

For future reference, a discussion of the errors in patentees' other calculations is warranted.

Patentees assert that they are entitled to a period of adjustment due to examination delay, pursuant to 37 CFR §1.702(a)(1) of 701 days for the failure by the Office to mail

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<sup>1</sup> See 35 U.S.C. 371(b) and (f).

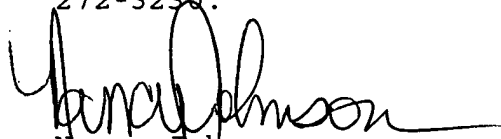
at least one of a notification under 35 U.S.C. 132 not later than fourteen months after the date the application's filing date. Patentees are informed that the 14 month provision is calculated from the date the application fulfilled the requirements of 35 U.S.C. 371 in an international application. Therefore, patentees' calculation is inaccurate. The application fulfilled the requirements of 35 U.S.C. 371 on October 5, 2005. Fourteen months after that date is December 5, 2006. The period of adjustment is from December 6, 2006 to May 2, 2007, which is 148 days. It is noted that the Office PTA calculations currently lists the adjustment in connection with the 14 month delay as 149 days. The adjustment of 149 days will be removed and an adjustment of 148 days will be entered. However, as discussed below, this change does not impact the patent term adjustment because applicant delay is greater than Office delay.

Patentees assert that the Office underestimated an applicant delay period. Applicants responded to the May 2, 2007 non-final Office action on July 27, 2007, but the response was deemed non-responsive by the Office. A complete response was not filed until December 10, 2007. Patentees assert applicant delay should be measured from August 2, 2007, the three month date for response to the Office action, to December 10, 2007 for a period of reduction of 142 days. Patentees are informed that this delay falls under 37 CFR 1.704(c)(7). A reduction of 136 days is in order because applicants' July 27, 2007 reply had omissions. A complete reply to the May 2, 2007 non-final Office action was filed on December 10, 2007. The period of reduction is measured from the day after the date the reply having an omission was filed, July 28, 2007, and ends on the date that the reply correcting the omission was filed, December 10, 2007. Therefore, the period of delay was properly calculated as 136 days.

In summary, at issuance, the Office properly entered no additional days of patent term adjustment for the Office taking in excess of 3 years to issue the patent and the Office calculation with respect to applicant delay was correct. The Office calculation with respect to Office delay was incorrect, however, even when corrected, no change to the over all patent term adjustment is warranted.

In view thereof, the Office affirms that the revised determination of patent term adjustment at the time of the issuance of the patent is 0 days.

Telephone inquiries specific to this matter should be directed to Shirene Willis Brantley, Senior Petitions Attorney, at (571) 272-3230.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a long horizontal flourish extending to the right.

Nancy Johnson

Senior Petitions Attorney

Office of the Deputy Commissioner

for Patent Examination Policy